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In re Patent Number 7,178,235 :
Issued February 20, 2007 :
David R. ROLSTON et al : DECISION ON PETITION
Application No. 10/725,566 : UNDER 37 CFR 1.78(a)(3)
Filed: December 3, 2003 :
Attorney Docket No. 16005-3US-1 AD/ad :

This is a decision on the renewed petition under 37 CFR 1.78(a)(3), filed November 12, 2008, to accept an unintentionally delayed claim under 35 U.S.C. §120 for the benefit of priority to the prior-filed nonprovisional application set forth in the concurrently filed amendment.

The petition is **DISMISSED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

The petition does not comply with item (1).

The reference to add the above-noted, prior-filed applications on page one following the first sentence of the specification is not acceptable as drafted since it improperly incorporates by reference the prior-filed applications. An incorporation by reference statement added after an application's filing date is not effective because no new matter can be added to an application

after its filing date (*see* 35 U.S.C. § 132(a)). If an incorporation by reference statement is included in an amendment to the specification to add a benefit claim under 35 U.S.C. § 120 after the filing date of the application, the amendment would not be proper. When a benefit claim under 35 U.S.C. § 120 is submitted after the filing of an application, the reference to the prior application cannot include an incorporation by reference statement of the prior application. *See Dart Industries v. Banner*, 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980). *Note* MPEP §§ 201.06(c) and 608.04(b).

Petitioner now inserts the language, “this patent application is a continuation-in-part of US non-provisional Patent Application No. 10/625,906”. The language is contrary to the original and sworn to language at page 1, paragraph 1, and “This is the first application filed for the present invention”. Petition, in their response should explain why the added continuation data is not contrary language distinct from the original statement. The language “This application is related to US non-provisional Patent application 10/625,906, filed July 24, 2003.” would not be contrary language.

Petitioner request reconsideration on the basis that the amendment filed December 3, 2003 application contained the incorporation by reference language now objected to. Specifically petitioner refers to the language, “This application is related to commonly assigned co-pending applications filed herewith bearing agent docket numbers 16005-1US titled “Optical Connector Assembly” and 16005-2US titled “Optical Ferrule”, the specifications of which are hereby incorporated by reference.” The statement “This application is also related to commonly assigned co-pending applications filed herewith bearing application number 10/625,905 titled: “Optical Connector Assembly” and 10/625,901 titled: “Optical Ferrule”, the specifications of which are hereby incorporated by reference”, was not originally filed. The insertion of attorney docket numbers followed by the phrase “the specifications of which are hereby incorporated by reference, does not permit petitioner to insert application numbers merely because they are required by the examiner and the Office. A subsequent insertion of the application numbers would require deletion of the incorporation by reference. Finally, it is not evidently clear that the original attorney docket numbers in the original specification are the same attorney docket numbers submitted on the transmittal sheets of application numbers 10/625,905 and 10/625,901.

Before the petition under 37 CFR § 1.78(a)(3) can be granted, a renewed petition under 37 CFR § 1.78(a)(3) an Application Data Sheet or a substitute amendment (complying with 37 CFR 1.121 and 37 CFR 1.76(b)(5)), which states the relationship of the prior-filed application to this application, are required.

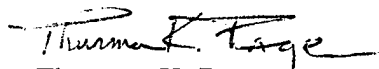
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Any questions concerning this matter may be directed to the undersigned at (571) 272-0602.


Thurman K. Page
Petitions Examiner
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